

REMARKS**I. Preliminary Matters**

This Preliminary Amendment is submitted with a continuation application that claims priority to application serial number 09/510,278. Claims 1-20 were filed in the parent application. In an Office Action dated May 22, 2003 for the parent application (“the parent Office Action”), the Examiner rejected claims 1-5, 14 and 18 under 35 U.S.C. § 102 or § 103. The remaining claims (6-13, 15-17, 19 and 20) were objected to or were rejected under 35 U.S.C. § 112, second paragraph, but were noted to be allowable if rewritten in independent form and if any antecedent problems were corrected. Applicants amended the claims in the parent application so that claims 1-5, 14 and 18, as originally filed, were no longer pending in the application. This preliminary again presents claims 1-5, 14 and 18 for consideration by the Examiner, while canceling the claims that remain pending/allowed in the parent application.

The relevant issues in the parent Office Action were:

- The Drawings were objected to as needing certain labels;
- Claims 2-9, 11-13, 15-17 and 19-20 were objected to for informalities;
- Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,481,495 to Henkels (hereinafter *Henkels*) in view of U.S. Patent No. 4,706,240 to Payne, III (hereinafter *Payne, III*); and
- Claims 14 and 18 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent No. 6, 215,325 to Southard (hereinafter *Southard*).

II. Amendments to the Drawings

Applicants have amended Figures 2, 4, 7 and 8A by adding the label “PRIOR ART.”

III. Claim Amendments

Claims 2-5 are amended to comply with the Examiner’s suggestion regarding antecedent basis. No new matter is added by the claim amendments.

IV. Previous Rejection under § 103(a) – combination of *Henkels* and *Payne, III*

The Examiner rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,481,495 to *Henkels* in view of *Payne, III*. Applicants respectfully traverse the rejection and assert that the rejected claims are allowable at least for the reasons stated below.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. M.P.E.P. § 2143. Without conceding any other criteria, Applicants respectfully assert that the cited references do not teach or suggest all the claim limitations, and, therefore, the claims are patentable under 35 U.S.C. § 103(a).

A. Failure to teach or suggest all claim limitations**1. Independent Claims**

Claim 1 requires:

a first bi-directional OR controller connected to said register file.

Henkels fails to teach this element of claim 1. *Henkels* teaches the implementation of the register file as an assembly of blocks consisting of sub-arrays and associated multiplexer circuits wherein for each read port, the outputs of the blocks are dot-Or'd together to form a single output. (*Henkels* col. 2, lns 20-24). The Examiner asserts this is a first bi-directional OR controller. (Parent Office Action at 4). Applicants traverse this suggestion. *Henkels* may teach an implementation of a register file, but it does not teach a bi-directional controller connected to a register file. *Henkels* does not mention or teach a controller connected to a register file. *Payne* fails to cure this deficiency. Thus, the combination of *Henkels* and *Payne* fails to teach all the elements of claim 1.

Claim 1 also requires:

a second bi-directional OR controller connected to said register file

Henkels also fails to teach this element. *Henkels* teaches a shift register configuration that is formed by adding a second cross-coupled inverter pair to the first cross-coupled inverter pair which is the main storage element. (*Henkels* col. 5, lns 2-8). In addition, *Henkels* teaches that the shifting of data into or out of a register is accomplished by alternately activating control lines which are inactive during normal cycles. (*Henkels*, col. 5, lns 9-12). This teaches a register configuration for shifting data into or out of a register. However, there is no teaching of a second bi-directional OR controller connected to the same register as the first bi-directional controller and *Payne* fails to cure this deficiency. Therefore, the combination of *Henkels* and *Payne* fails to teach all the elements of claim 1. Thus, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) for claim 1 be withdrawn.

2. Dependent Claims

Claims 2-5

Claims 2-5 depend directly or indirectly from base claim 1 and thereby inherit all of the limitations of the base claim. Accordingly, without conceding that the Examiner's assertions are valid with respect to the limitations of the rejected dependent claims, it is respectfully submitted that the dependent claims are allowable based on their dependency from independent base claim 1 for at least the reasons discussed above. Thus, Applicants respectfully submit that based on the arguments above, claims 2-5 are patentable under 35 U.S.C. § 103(a).

V. Previous 35 U.S.C. § 102(e) Rejection over *Southard*

The Examiner rejected claims 14 and 18 under 35 U.S.C. § 102 (e) as being anticipated by *Southard*. The Applicants respectfully traverse the rejection and assert that the rejected claims are allowable at least for the reasons stated below.

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. section 102 with respect to a claim, “[t]he elements must be arranged as required by the claim.” *See* M.P.E.P. § 2131, *citing In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Applicants respectfully assert that the disclosure of *Southard* does not

teach all the elements of the pending claims, and therefore, the claims are patentable under 35 U.S.C. § 102(e).

Claims 14 and 18

Claim 14 requires:

a circuit which combines said first raw select signal and said second raw select signal ***to determine which input should be used as a first conditioned select signal and a second conditioned select signal.***

Claim 18 requires:

a circuit which combines said first raw select signal and said second raw select signal ***to determine which input should be used as a first conditioned select signal, a second conditioned select signal and a third conditioned select signal***

Southard fails to teach these elements. *Southard* teaches a look-up table that performs an OR operation of a first and second data input and then inverts the result. (*Southard*, col. 7, lns 32-35). The inverted output is then coupled to the selector input of a multiplexor to enable the inverted output to function as a select signal. (*Southard*, col. 7, lns 35-39). *Southard* merely teaches inverting the result of an OR operation of two inputs and then allowing the result to be used as a select signal, but there is no mention of prioritizing inputs to determine which input is used first, which input is used second, or which input is used third. Thus, *Southard* fails to teach all the elements of claims 14 and 18. Therefore, Applicants request that the rejection under 35 U.S.C. § 102(e) for claims 14 and 18 be withdrawn.

VI. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10971265-3 from which the undersigned is authorized to draw.

Respectfully submitted,

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 256034751 US in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

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